

Attorney's Docket: 1999CH017
Serial No.: 10/070,622
Art Unit 1731

REMARKS

In the Official action of October 21, 2002, the Examiner indicated that this case was restricted into two groups, where:

Group I was drawn to claims 1-6, 9-11; and

Group II was drawn to claims 7-8.

For prosecution in this Application, Applicants elect class I, claims 1-6 and 9-11, with traverse.

Applicants note the Office's position that "each process is patentably distinct", stated in section 2, page 2, of the Office Action. However, it is incumbent upon the Office to provide Applicants with sufficient reasons as to why restriction is appropriate. Specifically, in MPEP § 808.02 it is stated:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05 (c) – § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

- (A) Separate classification thereof
- (B) A separate status in the art when they are classified together
- (C) A different field of search

(Underlining added)

Here, the Office has not shown that the claims of the application are classified in the separate classes and subclass. There is nothing in the Official action, which claims a separate status in the art when they are classified together nor is any claim made that a different field of search would be required.

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Therefore the Examiner has failed to met his burden MPEP § 808.02 and Applicants respectfully request that the Restriction be withdrawn.

Applicants courteously point out that the office has applied the incorrect standard for an appropriate restriction. For the national phase Applicants agree with the office that 35 USC 121 applies and that any arguments based on the PCT rules are not applicable. For the reasons given above the restriction is not proper. However, even if the PCT rules are to be applied there should be no restriction in this case.

Applicants note the Office's position that restriction is required under PCT 13.1 when the inventions are not so linked as to form a single general inventive concept. Specifically that under PCT Rule 13.2 they lack the same or corresponding technical features. Applicants traverse. The Office avers that claims 7-8 are anticipated or obvious from numerous references. The compositions of claims 7 and 8 are surface finishing agents, which are suitable for use in the process of claims 1-6 and thus belong to the same inventive concept.

The four documents cited by the office in addition to those already cited in the ISR are not closer than those mentioned in the ISR, and in the International Phase the unity of invention of claim 7 and 8 with the other claims was not objected to. Applicants respectfully request that the restriction based on unity of invention be withdrawn and the claims be examined.

Applicant would like to point out to the Examiner that an IDS was filed on this case on May 10, 2002. Applicant respectfully requests that these references be considered for the purposes of Examination.

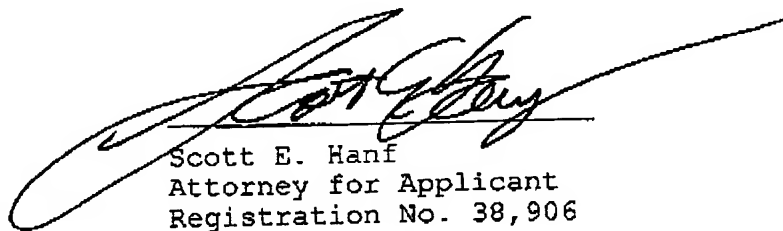
As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is

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required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

Reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Amend the Claims as follows:

1. (Amended) Process for the production of surface-finished paper or board (B_w), characterized in that an aqueous solution (L_w) of a surface-finishing active ingredient (W) is applied to a hydrophilic paper or board sheet (B),
in which (W) consists of
(W₁) polyethylene glycol with an average molecular weight \overline{M}_w of > 1500
[and optionally] or of (W₁) and at least one further additive which is a further finishing additive and/or a formulation additive,
and the paper or board sheet surface-treated with (L_w) is fed through smoothing rolls and dried.
3. (Twice Amended) Process according to Claim 1, characterized in that ([W] L_w) contains at least one non-finishing formulation additive (F).
7. (Amended) Surface finishing agent for paper or board which is a solution (L_w) as defined in Claim [4] 12, wherein (F) is (F₁) which is selected from,
(F₁₁) antifoams
and (F₁₂) agents for protecting against the damaging effect of microorganisms,
and with a (W₁)-content in the range of 0.1 to 20 %.
11. (Twice Amended) Process for the production of graphically processed paper or board by application of at least one graphic ink pattern to a substrate of paper or board, and drying.

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characterized in that the substrate used for this purpose is surface-finished paper (B_w) or surface-finished board (B_w) according to Claim [8] 9.

Add new claims 12-14 as follows:

12. Process according to Claims 1, characterized in that (L_w) essentially consists of (W) and water and at least one non-finihing formulation additive (F).
13. Process according to Claims 1, wherein (W) consists of (W₁) and at least one further finishing additive.
14. Process according to Claims 1, wherein (W) consists of (W₁) and a formulation additive.
15. Process according to Claims 1, wherein (W) consists of (W₁) and both a further finishing additive and a formulation additive.
16. Process according to Claim 1, characterized in that the further aditives are selected from finishing additives (W₂) and (W₃) and/or formulation additives (W₄), in which
(W₂) is at least one dye and/or optical brightener,
(W₃) is at least one wet strength additive
and (W₄) is at least one agent for pH adjustment.